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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,513	08/22/2005	Ralf Dunkel	CS8479/LeA 36187	9581

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EXAMINER	
STOCKTON, LAURA LYNNE	
ART UNIT	PAPER NUMBER
1626	

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09/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/530,513	DUNKEL ET AL.	
	Examiner	Art Unit	
	Laura L. Stockton, Ph.D.	1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *June 16, 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-25,27 and 30-33* is/are rejected.

7)☒ Claim(s) *26, 28 and 29* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claims 18-33 are pending in the application.

Response to Amendment

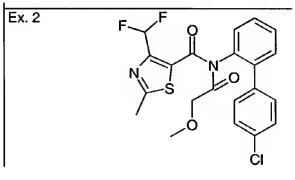
The Declaration under 37 CFR 1.132 filed June 16, 2008 is sufficient to overcome the rejections of the claims based upon 35 USC §103 over Elbe et al. {CA 2,474,902}, taken alone, or in combination with Kanji et al. {JP 08/176112} and obviousness-type double patenting over application 10/502,994 (matured as U.S. Pat. 7,388,097).

The Declaration under 37 CFR 1.132 filed February 23, 2007 is insufficient to overcome the rejection of claims 18-25, 27 and 29-33 based upon 35 USC §103 over Walter et al. {WO 02/059086}, taken alone, or in combination with Kanji et al. {JP 08/176112} as set forth in the last Office action

because the showing is not commensurate in scope with the instant claims. *In re Greenfield*, 197 U.S.P.Q. 227 (1978) and *In re Lindner*, 173 U.S.P.Q. 356 (1972). Also see M.P.E.P. 716.02(d).

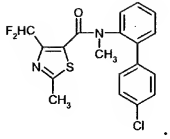
For instance, instant Example 1 (page 39), Examples 8 and 9 (page 41), etc. should also have been compared in the comparison study against compounds such as Compound No. 4.20 (page 32), Compound Nos. 4.43 and 4.44 (page 33) in Walter et al.

The Declaration of February 23, 2007 also suffers another problem. In Table 1, for example, under the heading "According to the invention", Example 2 is listed along with the following structure:



However, in the instant specification, Example 2 has the following structure:

Example 2



Therefore, it is not clear if the structure is incorrect in the Declaration or if Applicant incorrectly named the structure as Example 2. Hence, the Efficacy data found for these compounds "According to the invention" is in question. The compounds "According to the invention" and their Efficacy data in Tables II, III and IV also have the same issue.

Rejections made in the previous Office Action that do not appear below have been overcome by Applicant's submission of a persuasive Declaration under 37 CFR 1.132 filed June 16, 2008. Therefore, arguments pertaining to these rejections will not be addressed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 18-25, 27 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walter et al. {WO 02/059086}, taken alone, or in combination with Kanji et al. {JP 08/176112}. A partial translation of the JP document was provided with a previous Office Action and will be referred to hereinafter.

Determination of the scope and content of the prior art (MPEP §2141.01)

Applicant claims thiazole compounds. **Walter et al.** {see entire document; particularly pages 1, 2 and 8-16; and especially Compound Nos. 4.19 and 4.20 (page 32), Compound Nos. 4.43 and 4.44 (page 33); and Compound No.

7.03 (page 39)} teach thiazole compounds which are structurally similar to the instant claimed compounds.

Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The difference between the compounds of Walter et al. and the compounds instantly claimed is that the instant claimed compounds are generically described in Walter et al.

Further, **Kanji et al.** teach the interchangeability of the various substituents attached to the nitrogen of the carboxanilide group (see the definition of R1 in Kanji et al. in paragraph [0009]) in thiazole compounds that are useful as microbicidal agents.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

The indiscriminate selection of "some" among "many" is *prima facie* obvious, *In re Lemin*, 141 USPQ 814 (1964). The motivation to make the claimed compounds derives from the expectation that structurally similar

compounds would possess similar activity (e.g., controlling undesired microorganisms).

One skilled in the art would thus be motivated to prepare products embraced by Walter et al., especially in view of the teachings in Kanji et al., to arrive at the instant claimed products with the expectation of obtaining additional beneficial products which would be useful for controlling undesired microorganisms. The instant claimed invention would have been suggested to one skilled in the art and therefore, the instant claimed invention would have been obvious to one skilled in the art.

Response to Arguments

Applicant's arguments filed June 16, 2008 have been fully considered. Applicant argues that: (1) the Declaration under 37 CFR 1.132 by Dr. Wachendoff-Neumann filed February 23, 2007 shows that the instant claimed compounds having a difluoromethyl substituent

on the thiazole moiety is allegedly superior to a known comparison compound having a trifluoromethyl substituent; (2) the instant claimed compounds wherein R^6 represents a carbonyl group (i.e., $-COR^7$) are nonobvious over the compounds in Walter et al.; (3) Walter et al. do not describe the particular combination of structural features that characterize the carbonyl-containing embodiments of Applicant's claimed invention nor do Walter et al. show even one example of a N-carbonyl-substituted compound in which the A is thiazole and R_4 is a group other than CF_3; and (4) Kanji et al. would not lead those skilled in the art to the instant claimed invention.

All of Applicant's arguments have been considered but have not been found persuasive. Applicant argues the showing in the Declaration under 37 CFR 1.132 by Dr. Wachendoff-Neumann filed February 23, 2007. In response, the Declaration filed February 23, 2007 was found insufficient for reasons stated above.

Applicant argues that the instant claimed compounds wherein R^6 represents a carbonyl group (i.e., $-COR^7$) are nonobvious over the compounds in Walter et al. and that Walter et al. do not describe the particular combination of structural features that characterize the carbonyl-containing embodiments of Applicant's claimed invention nor do Walter et al. show even one example of a N-carbonyl-substituted compound in which the A is thiazole and R_4 is a group other than CF_3.

In response, it is strongly disagreed that the compounds of Walter et al. would not lead one skilled in the art toward the instant claimed compounds. See, for example, Compound Nos. 4.19 and 4.20 on page 32 in Walter et al. Each of these compounds in Walter et al. differ from the instant claimed compounds in that the thiazole ring is substituted with a **tri**fluoromethyl group at the 4-position of the thiazole ring instead of a **di**fluoromethyl group as instantly claimed. However, Walter et al. teach the interchangeability of a

trifluoromethyl group and a **di**fluoromethyl group at the 4-position of the thiazole ring (see the definition of the R_4 variable in Walter et al. on page 2). Further, it is well established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. *In re Boe*, 148 USPQ 507, 510 (CCPA 1966). It would appear that Applicant is arguing that if a rejection under 35 USC § 102 can not be made, than a rejection under 35 USC § 103 should not be made. However, this is not one of the factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a).

Applicant argues that Kanji et al. would not lead those skilled in the art to the instant claimed

invention. Applicant further argues that the reliance on the asserted interchangeability of amide substituents is insufficient to rebut the validity of their test results showing that the particular combination of features that characterize their invention. In response, Kanji et al. is a secondary reference and as such is not required to have all the limitations to meet the instant claims. Further, the Declaration filed February 23, 2007 was found insufficient for reasons stated above. For all the reasons given above, the rejection is deemed proper and therefore, the rejection is maintained.

Allowable Subject Matter

Claims 26, 28 and 29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be

directed to Laura L. Stockton whose telephone number is (571) 272-0710. The examiner can normally be reached on Monday-Friday from 6:15 am to 2:45 pm. If the examiner is out of the Office, the examiner's supervisor, Joseph McKane, can be reached on (571) 272-0699.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

The Official fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

/Laura L. Stockton/
Laura L. Stockton, Ph.D.
Patent Examiner
Art Unit 1626, Group 1620
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September 9, 2008